

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

REMARKS

This is a full and timely response to the Office Action of November 24, 2004. By the present Amendment, the claims have been amended to more particularly and distinctly point out the novelty and non-obviousness of the present invention. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

As previously stated, the present invention provides a system and method for enabling the facilitation and fulfillment of wireless e-commerce transactions in a secure and convenient manner. The present invention further assists in tying e-commerce transactions to "real world" products and services, and provides appropriate systems to enable users to bypass traditional physical world limitations associated with traditional transactions or only partially integrated e-commerce transactions. For instance, in the movie ticket example described in the specification of the present application, a user is able to bypass a ticket point-of-sale location and proceed directly into the theater using the present invention. The transaction for a product or service, as described in the rental car and movie ticket examples in the specification, can involve a payment obligation on behalf of the requester (e.g., rental of a car, movie ticket payment) and a fulfillment obligation on behalf of a provider to provide the product or service (e.g., rental company provides the rental car, movie theater allows entrance to view the movie). The scanning of the code sent to and displayed by the wireless device fulfills the requested and processed transaction.

Appl. No. 09/690,601
Amtd. dated April 25, 2005
Reply to Office Action of November 24, 2004

By displaying a transaction code on a wireless device display and optically scanning the code, the present invention enables *complete* transaction processing for a desired good or service. Fulfillment of an actual transaction (e.g., a purchase, sale, rental, lease, loan, borrowing, consigning, etc.) for a product or service is initiated and completed using the displayed code and an appropriate optical scanner. In one embodiment, scanning of the code from the wireless device display triggers a fulfillment event such as a physical event and/or an informational event. One type of information event is the removal of the requested product or service from being an available offering of the offering entity (e.g., a rented car is not available for rental to another, a movie ticket is not available for use by another and reduces the overall number of movie tickets so as not to exceed theater capacity). One type of physical fulfillment event is the allowance of admission to an event (e.g., a turnstile can be released to allow a moviegoer to proceed into the theater). Thus, the invention provides a system and method which truly facilitates and fulfills transactions for real-world goods and/or services.

By the present Amendment, claims 1, 21, 22, 37 and 38 have been amended to more particularly claim the facilitation and fulfillment of real-world transactions for goods and services by users of wireless devices.

Claim 1 has been amended to recite that the method therein pertains to a transaction involving a payment obligation on behalf of a requester and a fulfillment obligation on behalf of an entity offering a product or service to provide that product or service, wherein a transaction code is communicated to a wireless device and is representative of a wireless transaction requested by a

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

transaction requester that has indicated an acceptance of an obligation to pay for the requested product or service. Claim 1 as amended further recites that the method optically scans the transaction code *in fulfillment of the transaction* and triggers a wireless transaction fulfillment event in response thereto, *such that the provider thereby fulfills its obligation to provide the requested product or service and that product or service is thereby removed from being an available product or service offered by the entity*. Support for these claim amendments is found, for example, on page 16, lines 18-28, page 17, lines 1-4, page 22, lines 13-15 and page 23, lines 1-27, and no new matter is believed to have been added.

Similar to claim 1, claim 22 has been amended to recite a method for facilitating a wireless transaction involving a payment obligation on behalf of a requester and a fulfillment obligation on behalf of an entity offering a product or service to provide that product or service including the steps of receiving a transaction request for a product or service from a transaction requester that has indicated an acceptance of an obligation to pay for the product or service, verifying an identity of the transaction requester and communicating a transaction code representative of a wireless transaction for the requested product or service. Claim 22 as amended further recites that the method includes the steps of optically scanning the transaction code *in fulfillment of the transaction* and triggering a wireless transaction fulfillment event in response thereto, *such that the provider thereby fulfills its obligation to provide the requested product or service and that product or service is thereby received*.

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

Similar to claims 1 and 22, claim 37 has been amended to recite a system for facilitating a wireless transaction involving a payment obligation on behalf of a requester and a fulfillment obligation on behalf of an entity offering a product or service to provide that product or service including means for communicating a transaction code representative of a wireless transaction for a product or service requested by a transaction requester that has indicated an acceptance of an obligation to pay for the product or service. Claim 37 as amended further recites that the system includes means for optically scanning the transaction code *in fulfillment of the transaction* and means for triggering a wireless transaction fulfillment event in response thereto, *such that the provider thereby fulfills its obligation to provide the requested product or service and that, product or service is thereby received.*

Claim 21 has been amended to recite steps of the embodiment of the invention including receiving a transaction request for admission to an event from a transaction requester where the event is selected and paid for by the transaction requester in connection with the transaction request, optically scanning, by a transaction fulfillment system, a transaction code from a visual display of a wireless communication device, wherein the code is representative of the requested transaction for admission to the selected and paid-for event, and enabling fulfillment of the transaction request in response to scanning the transaction code, including triggering at least one physical fulfillment event to allow admission to the selected and paid-for event. It will be appreciated that the event may be any of a number of real-world experiences or services including a movie, sporting event or a plane flight, for example. Claim 38 has been amended to include language similar to that provided in amended claim 21.

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

Response to 35 USC 102 and 103 rejections

In the Office Action dated November 24, 2004, the Examiner has rejected claims 1-4, 6, 10-15, 19-20, 22, 24-29 and 33-37 under 35 USC 102(e) based on U.S. Patent Application Publication No. 2002/0004746 A1 to Ferber et al. (hereinafter "Ferber"). The Examiner has further rejected claims 30-32 under 35 USC 103(a) as being unpatentable over Ferber in view of U.S. Patent No. 5,590,038 to Pitroda ("Pitroda"). The Examiner has further rejected claims 5, 7-9, 16-18, 21 and 38 under 35 USC 103(a) as being unpatentable over Ferber. While the Examiner has listed by name and number the previously cited Melick et al. reference on page 5 of the Office Action in rejecting claims 30-32 and claims 5, 7-9, 16-18, 21 and 38, it is apparent that this is a typographical error and that the Ferber reference is employed as the primary reference in making these rejections. Regardless, based on the above amendments and the present remarks, Applicant submits that these rejections have been traversed and that the present claims are allowable over all prior art of record, considered singly or in combination.

In considering the present amendment and remarks, Applicant notes that the Ferber reference may only be used to support a rejection under 35 USC 102(e) or 35 USC 103(a) to the extent supporting subject matter is present in the provisional application relied upon by Ferber for priority (i.e., U.S. 60/198,092 filed April 17, 2000 (the '092 application)), as this is the only application with a priority date which predates Applicant's priority filing date of July 13, 2000. Applicant respectfully submits that any elements cited by the examiner from the Ferber

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

publication which were not in the '092 application cannot be considered against Applicant's claims.

The Ferber reference cited by the Examiner describes an e-coupon channel for use with providing electronic coupon incentives based on user profiles (see abstract; paragraph [0002]). The aim of the Ferber reference is to provide and send appropriately targeted coupons to users to increase response rate, reduce fraud, and reduce administrative processing costs (see paragraph [0005]). Users of the delivered coupons present them at a location with a cash register in order to redeem the coupon (see paragraph [0025]); thus, the user does not bypass traditional real-world physical limitations when attempting to purchase a product or service in light of the Ferber disclosure. Further, no payment or fulfillment obligation for a product or service is involved, and any purchase transaction for a product or service must still be processed in the standard way.

In contrast to the Ferber reference, the present invention as presently claimed provides for *fulfillment* of a transaction for a product or service involving a payment obligation on behalf of a requester and a fulfillment obligation on behalf of an entity offering the product or service to provide that product or service. In the present invention, the scanning of a displayed code on the visual display of a wireless device is performed in fulfillment of the transaction, and a fulfillment event is thereby triggered whereby the entity offering a product or service fulfills its transacted obligation. In contrast, no payment obligation is incurred by the user in Ferber, as the user merely receives a coupon pushed to it by the e-coupon server, wherein the coupon may either be used or it goes expired. No product or service is transacted for by the user, and no fulfillment obligation is

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

incurred by the entity offering the product or service. While the user can select the frequency of coupon delivery (see paragraph [0029]) and the user can initiate a request for coupons to the e-coupon server (see paragraph [0028]), no payment obligation is involved by the user, and indeed after the coupon information is entered at a point-of-sale location, the user must still provide payment in order to receive a product or service.

It is thus Applicant's position that the Ferber reference teaches away from the facilitation of a transaction to bypass traditional real-world limitations as in the present invention, as the scanning of the barcode in Ferber merely processes a coupon, and does not result in fulfillment of the offering entity's obligation to provide a product or service, as requested by the transaction requester who has accepted a payment obligation for the requested product or service. Further, there is no teaching or suggestion in Ferber of removing a product or service for which the offering entity's obligation has been fulfilled from being an available product or service. For these reasons, Applicant submits that there is no teaching or suggestion of the invention as presently claimed in amended claims 1, 22 and 37.

Applicant further submits that there is no teaching or suggestion in Ferber or any of the other references of record of the elements of claims 21 and 38, namely: receiving a transaction request for admission to an event from a transaction requester where the event is selected and paid for by the transaction requester in connection with the transaction request; optically scanning, by a transaction fulfillment system, a transaction code from a visual display of a wireless communication device, wherein the code is representative of the requested transaction

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

for admission to the selected and paid-for event; and enabling fulfillment of the transaction request in response to scanning the transaction code, including triggering at least one physical fulfillment event to allow admission to the selected and paid-for event. As discussed above, Ferber is not concerned with facilitating fulfillment of transactions for a requested and paid-for product or service and the offering entity's obligations therefor. Nor is there any teaching or suggestion in Ferber of triggering a physical fulfillment event to allow admission to a selected and paid-for event. The Examiner has cited paragraphs [0025] and [0030] for the proposition of "enabling fulfillment of the transaction request in response to scanning the transaction code, including triggering at least one physical fulfillment event"; however, there is no discussion whatsoever in these paragraphs of triggering a physical fulfillment event, much less triggering a physical fulfillment event to allow admission to a selected and paid-for event, as presently claimed. Applicant further submits that the present claims cannot be obviated by taking official notice that coupons have been frequently used for obtaining admission to an event. Applicant submits that claims 21 and 38 must be viewed in their entirety, and that there is no teaching or suggestion of triggering at least one physical fulfillment event to allow admission to a selected and paid-for event as part of enabling fulfillment of a transaction request in response to scanning the transaction code, as claimed in amended claims 21 and 38.

Regarding the rejection of claims 7-9 and 16-18, the Examiner has stated that these claims would have been obvious to one having ordinary skill in the art at the time of applicant's claimed invention. However, the Examiner has cited no references in addition to the Ferber reference and has cited *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (7th Cir. 1977), for the

Appl. No. 09/690,601

Amdt. dated April 25, 2005

Reply to Office Action of November 24, 2004

proposition that mere duplication of the working parts of a device or duplication of steps involves only routine skill in the art. The facts of the *St. Regis* case indicate that the applicant was attempting to patent a combination of two old elements, and the court properly held that such a combination is not patentable unless the combination is synergistic, i.e., resulting in an effect greater than the sum of the several effects taken separately. *Id.* at 11. It is Applicant's position that this case is not properly applied to Applicant's invention as claimed, as Applicant is not combining two old elements, and the additional steps of communicating a second fulfillment verification to the transaction management system or communicating a second transaction code to the wireless communication device, as claimed in these claims, would not have been obvious and does not represent a "mere duplication of the essential working parts of a device or duplication of steps". Indeed, such additional steps provide a synergistic effect in the facilitation of multiple-stage e-commerce transactions.

As described in the specification, certain commercial transactions may necessarily require conditional communication of verifications or transaction codes, depending upon earlier events. For instance, in the rental car example, if the wireless device user does not scan a first transaction code indicating his or her arrival at an airport, it may not be necessary to maintain his or her reservation and it may not be necessary to issue a second transaction code for the user to use in indicating arrival at the car rental lot. Because these types of verifications and codes do not represent a combination of old elements, duplication of steps or duplication of working parts, Applicant submits that such steps as claimed would not be obvious to one having ordinary skill in the art at the time of the invention, considered in light of any of the prior art of record.

Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

Applicant separately submits that dependent claims 7-9 and 16-18, as well as the remaining dependent claims, are allowable based upon being dependent from an allowable independent claim.

Applicant respectfully reiterates that none of the references of record, taken singly or in combination, discloses or suggests the invention as presently claimed.

Response to Provisional Double Patenting Rejections

Claims 1-20, 22 and 24-37 presently stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over specifically cited claims of co-pending Application Serial No. 09/690,212. Noting that these rejections are provisional, and in light of the present Amendment, Applicant submits that subject claims are patentably distinct from the cited claims of co-pending Application Serial No. 09/690,212. Applicant therefore respectfully requests that these rejections be withdrawn, once the present application is otherwise in condition for allowance.

For the above reasons, Applicant submits that none of the cited references, taken either singly or combined, teaches or suggests the system and method of the present invention as presently claimed, and that the rejections in the Office Action of November 24, 2004 have been traversed.

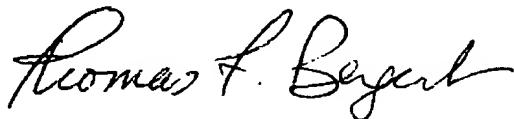
Appl. No. 09/690,601
Amdt. dated April 25, 2005
Reply to Office Action of November 24, 2004

CONCLUSION

Based on the foregoing, Applicant submits that the present application is in position for prompt adjudication and allowance. Applicant believes that all of the claims currently pending in the present application are now in condition for allowance, and an early notice to that effect is earnestly solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the present application, the Examiner is invited to contact Applicant's undersigned representative at the address and phone number provided below.

A two-month extension of time is being filed simultaneously with this Amendment. The Commissioner is hereby authorized to charge Deposit Account No. 50-0766 in payment of the required fees.

Respectfully submitted,
WILLIAMS MULLEN, PC



Thomas F. Bergert
Counsel for Applicant
Reg. No. 38,076

Filed: April 25, 2005
Attached: Petition for 2-month extension of time

Thomas F. Bergert, Esq.
Williams Mullen, PC
8270 Greensboro Drive, Suite 700
McLean, Virginia 22102
(703) 760-5200
tbergert@williamsmullen.com
1135421